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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/255,052	02/22/1999	ANTOINE BOUCHER	1206	7929--

7590

02/06/2004

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EXAMINER
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SRIVASTAVA, VIVEK

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 02/06/2004

16

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/255,052

Applicant(s)

BOUCHER ET AL.

Examiner

Vivek Srivastava

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 66-76 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 66-76 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9. 6) ☐ Other:

## **DETAILED ACTION**

### ***Response to Arguments***

The Applicant argues "If anything, Kunkel et al, point away from using MPEG, when they suggest that downloaded information should be in a standard HTML Internet format".

The Examiner respectfully disagrees. Kunkel simply discloses using HTML internet format. Kunkel does teach away from using MPEG since Kunkel does not disclose any advantages of using HTML in lieu of MPEG and also does not address and limitations in using MPEG. As a result, the Applicant's arguments are not persuasive.

Applicant argues "Present public knowledge by the Examiner is not prior art to a an application filed February 22, 1999." The Examiner notes that this is in response to the Official Notice taken that 'it is well known in the art to store data in MPEG format to provide compressed storage for utilizing less memory' and 'that it would have been well known in the art to include positional data with interactive content'.

To support the Examiner's position on the Official Notice taken, the Examiner cites Ferguson (5,815,793) which teaches a VOD system which stores compressed MPEG video data (col 8 lines 6 - 19) and Kikinis (5,929,849) which teaches providing positional information with URL to ensure a proper display position for the URL (see col 6 line 50 – col 7 line 9).

With regards to claim 65, Applicant argues that the Examiner similarly asserts that it is his personal knowledge that "it would have been well known in the computer art to include the claimed limitations to monitor and keep track of data sent to a user based on the User's ID" and that the Examiner used impermissible hindsight and that combination would not be proper.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

To support the Official Notice take the Examiner cites Block (4,163,254) and Pires (4,163,255). Block teaches monitoring and keeping track of data sent to a user based on the user's ID (see col 5 lines 15-29).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 64-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kunkel (5,961,603).

Considering claim 64, Kunkel discloses a system for interactive distribution of selectable presentations, the system having presentation server (met by data collection center 34 and database 42 in fig 1), a headend 14 (see fig 1) coupled to the presentation server and a broadband distribution network (see col 1 lines 47-55) and addressable processing equipment (met by settop boxes in col 7 lines 3-10). Further, Kunkel discloses transmitting a presentation request from the addressable equipment at the user location to the presentation server (see col 3 lines 2-17), note: since the server provides the settop with the data requested, a destination address corresponding to the addressable processing equipment is inherently included. Kunkel further discloses the master database 42 (fig 1) receives programming from the uplink center database 40 (fig 1) which in turn provides the data to data collection center 34 (fig 1) for storage and thus discloses receiving a plurality of selectable presentations at the presentation servers and storing the selectable presentations in a presentation database (also see col 5 line 44 – col 6 line 9). Kunkel also discloses the communication may be MPEG II format and since the data is combined in a single channel for delivery to the settop Kunkel inherently discloses the claimed multiplexing.

Kunkel fails to disclose the claimed storing selectable presentations in MPEG digital format in a presentation database memory. The Examiner takes Official Notice it

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would have been well known in the art to store data in MPEG format to provide compressed storage for utilizing less memory. For example, the system in Ferguson (5,815,793) teaches a VOD system comprising a archival storage which stores compressed video data (see col 8 lines 6-15). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kunkel to include the claimed limitations to provide less memory used for storage.

Kunkel fails to disclose the claimed receiving position information for presenting the selected presentation. The Examiner takes Official Notice it would have been well known in the art to include positional data with interactive content to provide a more pleasing viewing experience or to ensure data is displayed in its proper location on the display. For example, the system in Kikinis (5,929,849) teaches including positional data with a URL to ensure the URL is positioned correctly (see col 6 line 50 – col 7 line 10). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the claimed limitation to ensure the data is correctly displayed and to enhance the viewer's viewing experience.

Regarding claim 65, Kunkel fails to disclose the claimed transmitting a log on request from addressable processing equipment, receiving a user number from presentation server at processing equipment, using the user number to identify MPEG digital video signals transmitted from the presentation server to the processing equipment. It would have been well known in the computer are to include the claimed limitations to monitor and keep track of data sent to a user based on a user's ID. For example, the system in Block (4,163,254) teaches keeping track of subscriber accessed

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programs according to a subscriber ID for billing purposes (see col 5 lines 15-27).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kunkel to include the claimed limitations to monitor and keep track of data sent to a user.

Regarding claims 66-70 Kunkel discloses the claimed MPEG limitations (see col 5 lines 35-43, note MPEG P-frame overlay would be inherent since one of the frames of the presentation would have been a P-frame).

Regarding claim 71, Kunkel discloses an MPEG II transmission system and thus discloses the claimed limitations which are inherent in an MPEG II system.

Considering claim 72, Kunkel discloses the claimed presentation request form addressable processing equipment at the user location to presentation server is transmitted over a two-way broadband signal distribution network (see col 1 lines 43-60 and col 2 lines 41-62).

Considering claim 73, Kunkel fails to disclose the claimed wherein presentation request for addressable processing equipment as the user location is transmitted over telephone line. It would have been obvious transmitting upstream data via telephone lines and not a bi-directional cable network would have reduced upstream traffic and ingress noise resulting from upstream traffic in a cable network. Therefore, it would have been obvious to one skilled in the art to modify Kunkel to include the claimed limitation to limit upstream traffic and ingress noise in cable network.

Regarding claim 74, see claim 64.

Regarding claim 75, Kunkel discloses the claimed URL (see col 2 lines 29-32).

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Eyer et al (5,982,445) – Hyptertext TV display and control

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

(703) 308-9051, (for formal communications intended for entry)



**Or:**

(703) 308- 5399 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivek Srivastava whose telephone number is (703) 305 - 4038.

The examiner can normally be reached on Monday - Thursday from 8:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andy Faile, can be reached at (703) 305 - 4380.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703) 305 - 3900.

VS

12/27/03



**VIVEK SRIVASTAVA  
PRIMARY EXAMINER**